

Remarks

The Examiner states that the Supplemental Information Disclosure Statement filed on December 15, 2003 fails to comply with 37 C.F.R. § 1.98(a)(2). In particular, the Examiner states that a legible copy of the patents, which were all foreign patents, were not included. This is not the case. Enclosed herewith is a copy of the return postcard which indicates that the patent copies for this Supplemental Information Disclosure Statement were received by the OIPE on December 15, 2003. Through no fault of the Applicant, the patent copies were apparently misplaced before the Supplemental Information Disclosure Statement was received by the Examiner. In order for the Examiner to consider these foreign references, additional copies of these references are enclosed herewith. Applicant submits that these references do not disclose the invention as claimed in the subject application and are merely cumulative of previously submitted references. However, Applicant is providing these references to ensure full compliance with their duty of disclosure. Regarding the non-English foreign documents, each of these references disclose a pedal assembly that corresponds to a previously submitted U.S. patent and/or an adjustable pedal that actuates a control cable during operation.

Claims 26-50 remain in the Application with Claims 26, 36 and 42 being in independent form. None of the claims are being amended in this Request for Reconsideration.

Claims 26-50 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Huff et al. (U.S. Patent No. 2,860,720) in view of French Patent No. 2 739 947. In particular, the Examiner believes it would have been obvious to utilize the modular electric signal generator of the French Patent between the pedals and support structures of Huff et al. The Examiner states that the motivation for this combination is that in the use of a modular mounting structure of accelerator, brake, and/or clutch electric actuators would make for easier production, in terms of less labor, with a reduction in parts. The Examiner also states that the need for the linkage 66 and the parts connected beyond (i.e. master cylinder, etc.) in Huff et al. would be superfluous (and detrimental to the overall function of the assembly) and therefore eliminated. The Examiner goes on to state that the combination of Huff et al. with the French patent would eliminate the linkage such that the

electrical signal actuator of the French patent would be pivotally fixed with respect to the adjustment means of Huff et al. and would only pivot about its axis of rotation upon actuation by the driver.

Applicant understands the Examiner's position relative to the obviousness combination of the electrical generator disclosed in the French Patent with the adjustable pedal assembly of Huff et al.. However, Applicant contends that this combination is improper and can not be made without violating the required standards of non-obviousness set forth in 35 U.S.C. § 103 and discussed in *Graham v. John Deere*, 383 U.S. 1, 86 S. Ct. 684, 15 L. Ed. 2d 545 (1966).

The Examiner concedes that the linkage and the operation of pivoting of the pedal during adjustment as set forth in Huff et al. is "detrimental to the overall function of the assembly" if an electric signal generator is used on the adjustable pedal assembly of Huff et al. Irrespective of this finding, the Examiner disregards (eliminates) this component and operation and grossly simplifies the combination of features for the subject invention. With this simplification, the Examiner jumps to an obviousness conclusion. Applicant encourages the Examiner to revisit this obviousness conclusion and take a close examination of the prior art to be combined to evaluate whether or not this combination requires the elimination of critical parts, renders the prior art design unsatisfactory for its intended purpose, or changes the principal operation of the reference. As set forth below, if any of these three criterion occur then the obviousness rejection is improper.

It is well-settled that critical parts of a prior art device (such as the linkage and operation of the adjustable pedal assembly in Huff et al.) cannot be discarded in order to formulate an obviousness rejection. With reference to the United States Court of Appeals case of *UARCO, Inc. v. Moore Business Forms, Inc.*, 440 F.2d 580, 169 U.S.P.Q. 263 (1971), the appeals court reiterated the stated law that portions of a prior device cannot be discarded in order to formulate an obviousness rejection. In particular, the *UARCO* case focused on the issue of using multiple references in an obviousness rejection where some features of the prior art references must be eliminated in order to make the combination. The patent in question (the '799 patent) was argued to be invalid based on obviousness in light of two prior art patents (the '886 and '971 patents). The claims of the '799 patent

cover a series of sealed stuffed envelopes with attached inserts. The key to the claims is that there was a single tear strip to hold the insert in place. The '886 patent disclosed a similar series of sealed stuffed envelopes with inserts. However, the inserts were attached to the envelopes at four sides such that four tear strips were required. The idea of a single tear strip, however, was known by the '971 patent. The '971 patent disclosed a single envelope with an insert that was held in place by a single tear strip. As such, it was argued that it would be obvious to combine the '886 patent with the '971 patent to find all the features of the '799 patent. In analyzing this obviousness challenge, the court looked closely at the prior art (the '886 and '971 patents) to determine if any features had to be discarded during that combination. In particular, the court found that the insert sheet of the '886 patent had to be discarded and replaced with a different shaped insert similar to the one found in the '799 patent. Regarding the '971 patent, the court found that the single envelope had to be replaced with a series of envelopes. The court then concluded;

We have stated that where the parts of the prior art device must be discarded in order to get to the patented invention, then such art does not make the invention obvious under the provisions of 35 U.S.C. § 103. *Ortman v. Maass*, 7, 391 F.2d 677 (7th Cir. 1968).

Accordingly, the court reasoned that critical parts of the prior art designs cannot be removed in order to formulate an obviousness combination.

Turning to the subject rejection, the Examiner is attempting to remove not only the linkage in Huff et al. but also the principal operation of the pedal in Huff et al. as the pedal is being adjusted. Hence, the Examiner is attempting to discard two critical features of the adjustable pedal assembly of Huff et al. According to stated law as set forth in the *UARCO* case, the discarding of these features of the adjustable pedal assembly of Huff et al. is improper when formulating an obviousness rejection such that the current obviousness rejections must be withdrawn.

In addition to the above and as stated in detail in Applicant's previous Response, Applicant contends that the principal operation of the adjustable pedal assembly of Huff et al. would be changed if the electronic generator of the French Patent was combined with Huff et al., and that the adjustable pedal assembly of Huff et al. would be unsatisfactory for

its intended purpose. The principal reason for Applicant's contentions relate to the pivoting of the pedals, 62, 60 during adjustment. This is a critical and principal operation of the adjustable pedal assembly of Huff et al., which *cannot be changed even if the linkage was eliminated*. Applicant contends that even if the linkage of Huff et al. was removed, which cannot be properly done as discussed above, the principal operation of the adjustable pedal assembly of Huff et al. cannot be changed. In other words, **even if the linkage is removed, the pedals must still pivot during adjustment** because that is the principal operation of the adjustable pedal assembly of Huff et al. Accordingly, if an electronic generator was placed onto the pedal of Huff et al., the electronic generator would sense a signal during the adjustment of pedal, which would accelerate and/or brake the vehicle during adjustment. In summary, the Examiner cannot alter the principal operation of the adjustable pedal assembly of Huff et al. and cannot render the adjustable pedal assembly of Huff et al. unsatisfactory for its intended purpose such that the current obviousness rejections must be withdrawn.

As also stated in Applicant's previous Response, the claimed invention requires that an adjustment element move a pedal between a plurality of operable positions without pivotally rotating the pedal about a first pivot axis. Also, the independent claims require that the movement of the pedal between the operable positions by the adjustment element be independent of the rotation of the pedal between rest and applied positions. As such, the electrical generator claimed in the subject invention does not sense any rotation of the pedal about the first pivot axis during adjustment of the pedal about the second pivot axis. This creates a novel and non-obvious design improvement that is not found or suggested by the prior art of record. The claimed invention is therefore believed to be novel and non-obvious over the adjustable pedal assemblies without electrical generators either alone or in combination with any of the other cited references.

Accordingly, it is respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. The Commissioner is authorized to charge our Deposit Account No. 08-2789 for any fees or credit the account for any overpayment.

Respectfully submitted,

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Howard & Howard

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Inventor / Applicant: Mattias Johansson et al. Mark: 65,748-753
Date: 12.10.03 Attorney: JGH File No.: 65,748-753

- PATENTS / TRADEMARKS -

☐ New Patent Application: ☐ CON ☐ CIP ☐ DIV ☐ FWC ☐ Provisional ☐ PCT

☐ Page(s) Specification ☐ Page(s) Claims ☐ Page(s) Abstract ☐ Page(s) Drawing (formal/informal) ☐ Page(s) Transmittal Cover Sheet ☐ Page(s) Missing Parts

☐ Small Entity Declaration ☐ Executed Declaration & Power of Attorney ☐ General Power of Attorney ☐ PTO 1449 ☐ Response to Invitation ☐ Certificate of Mailing ☐ Section 15 Affidavit ☐ Maintenance Fee Transmittal, ___ Year

☐ PCT Request ___ Pages ☐ Fee Calculation Sheet ☐ Information Disclosure Statement ☐ Recordation Cover Sheet ☐ Extension of Time ☐ Section 8 Affidavit ☐ Issue Fee Transmittal

☐ Certificate of Express Mail ☐ Assignment ☐ Response/Amendment ☐ Statement of Use ☐ Priority Document

☐ Notice of Appeal ☐ Appeal Brief ☐ Renewal Application ☐ Change of Fee Address ☐ Make of Record Letter

Other: _____

Fee: \$ _____ Serial/Patent/Registration No. 19/091,889
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